The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES
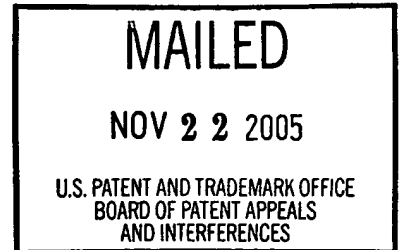
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Ex parte LEO K. VAN ROMUNDE and
PAUL CLAUDE KAISER

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Appeal No. 2004-1825
Application 09/402,563

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ON BRIEF

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Before JERRY SMITH, OWENS, and MACDONALD, *Administrative Patent Judges.*

OWENS, *Administrative Patent Judge.*

ON REQUEST FOR REHEARING

The appellants request rehearing of our decision (mailed March 30, 2005 and remailed April 22, 2005) wherein we affirmed the rejection of claims 1-3, 5-10, 12-14, 16 and 17 under 35 U.S.C. § 102(b) over McIlroy and entered a new ground of rejection of claim 11 under 35 U.S.C. § 112, second paragraph.[1]

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[1] In accord with Manual of Patent Examining Procedure § 1214.01(II)(8th ed., August 2001) the appellants address the affirmance in one paper (referred to herein as request I) and the
(continued...)

1

Affirmance of the rejection of
claims 1-3, 5-10, 12-14, 16 and 17

The appellants argue that McIlroy does not disclose at least one recorded catalogue of recommended actions that comprises hierarchized sequences of alternative actions because the guideline treatment database items in McIlroy's figure 7 are not hierarchized and the guideline treatment options in McIlroy's figures 15 and 16 are not recorded (request I, pages 4-6). The appellants' specification states that "[t]he expression 'record' as used here refers to a capability of the method to store information in a retrievable way in the system" (page 3, lines 17-19). That definition does not exclude McIlroy's storing of treatments (figure 7) and using an algorithm to retrieve the treatments and put them in hierarchized sequences (figures 15 and 16).

The appellants argue that there is no hierarchical order between McIlroy's recommended treatments 2A and 2B (figures 15 and 16), and that treatments 2C and 2D (figure 16) are not in hierarchical order (request I, page 5). McIlroy's recommended treatments 2A and 2B are hierarchized relative to treatments 2C and

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[1](...continued)
new ground of rejection in a separate paper (request II).

2D which are not preferred. Hence, McIlroy discloses hierarchized

sequences of alternative actions.

The appellants argue that their specification requires that a

subform is integrated into another form (request I, pages 6-8). The

portion of the specification relied upon by the appellants (page 6,

lines 11-18) states that a main form "can comprise" one or more

subforms and that a subform "can be integrated" in several forms.

That portion of the specification does not require such

integration.[2] The appellants argue that contrary to the board's

interpretation, the appellants' figure 1 does not indicate that

subforms can be screens generated from another screen but, instead,

shows subforms being used as links (request I, page 8). Regardless

of whether the subforms are used as links, the figure shows that the

appellants' subforms appear to include screens that are generated

from another screen.

The appellants argue that McIlroy's figures 10-14 cannot be

generated for each step in a recommended treatment in figures 15 and

16 because when figures 10-14 appear, figures 15 and 16 do not yet

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[2] The appellants further argue (request I, page 6) that an
example states: "Subform is then incorporated in evaluation
subform" (page 12, lower right box). That example does not
indicate that the incorporation is a requirement of the claimed
invention.

exist (request I, page 9). McIlroy's hierarchies of forms and subforms in figures 10-16 are generated for setting forth the sequential steps of the hierarchized alternative actions in figures 15 and 16 and, therefore, are generated for each of those steps.

The appellants argue that McIlroy's figures 10-14 are not generated in function of the treatment options in figures 15 and 16 because information must be inputted into the forms in figures 10-14 before the lists of treatment options in figures 15 and 16 exist (request I, page 11). The appellants interpret "in function of" as meaning "as a function of." *See id.* The appellants' specification, however, does not define "function" that narrowly. As pointed out in our decision (page 7), the relevant dictionary definition of "function" is "[s]omething closely related to another thing and dependent on it for its existence, value, or significance". The purpose of the information in figures 10-14 is to produce the list of treatment options in figures 15 and 16. Hence, the generation of the forms in figures 10-14 depends for its value or significance on the list of treatment options in figures 15 and 16.

The appellants argue that the past history in McIlroy's figure 6 is questions and answers, not alternative actions (request I, page 12). The appellants' claims recite "past history of actions," not "past history of alternative actions." As pointed out in our

4

decision (page 8), past history of actions is taken into account in McIlroy's figure 6. The appellants argue that interpreting "in function of" as meaning "take into account" is inconsistent with interpreting that term according to the definition set forth above (request I, page 12). In accord with the above definition, the past actions in figure 6 and the recommended treatments in figures 15 and 16 depend upon each other for their value and significance.

The appellants argue that McIlroy does not disclose transferring evaluation forms and subforms in one operation into one file (request I, pages 13-15). What the appellants' claims require is that such transferring is enabled. The appellants argue that "[t]he Board has not explained where McIlroy discloses that the implementation of a method on a personal computer using Microsoft C language would enable the system to transfer at least two *forms* into a single file" (request I, page 14). In our decision we pointed out several of McIlroy's disclosures that, taken together, indicate that the system enables transferring at least two forms into a single file using a single instruction (pages 8-9). The appellants have not explained why those combined teachings do not indicate such enablement.

The appellants argue (request I, page 16) that the board has not provided any basis in fact or technical reasoning to support its

statement that "McIlroy necessarily must have an algorithm for selecting the treatments in figures 15 and 16 from the menu in figure 8, and for specifying the recommended treatments and placing them at the beginning of the lists in figures 15 and 16" (decision, page 9). It is self-evident that one cannot carry out processes of selecting, specifying and placing without an algorithm (i.e., procedure) for doing so.

The appellants request that we designate the affirmance as a new ground of rejection (request I, pages 16-18). Because, as argued by the appellants, our rationale differs substantially from that of the examiner, we denominate the affirmance of the rejection of claims 1-3, 5-10, 12-14, 16 and 17 under 35 U.S.C. § 102(b) over McIlroy as involving a new ground of rejection.

New ground of rejection of claim 11

The appellants argue that 1) Lotus Notes® and Lotus Domino Notes® are so well documented that one of ordinary skill in the art, after reviewing the appellants' specification, would readily determine the scope of claim 11 without the version being recited, 2) the appellants' filing date indicates the time frame of the program used in the invention, and 3) the appellants' specification (pages 8-9) correlates certain features of the invention with capabilities of Lotus Notes® and Lotus Domino Notes® (request II,

Application 09/402,563

page 2). The appellants' specification does not limit claim 11 to

the Lotus Notes® and Lotus Domino Notes® versions in effect as of

the appellants' filing date. Instead, claim 11 encompasses any

programs created before, on or after the filing date having the

names Lotus Notes® and Lotus Domino Notes®, regardless of how

dissimilar they are to that version. Thus, in view of the

specification, the scope of the claim is unclear. The appellants

argue that the fact that 1) the examiner, the examiner's supervisor

and the appeal conference specialist, all of whom the appellants

presume to be of ordinary skill in the art, did not find claim 11

indefinite for failing to recite the version dates of Lotus Notes®

and Lotus Domino Notes®, and 2) at least 13 patents containing

dependent claims which recite Lotus Notes® without a version or

date, indicates that one skilled in the art would readily determine

the scope of claim 11 (request II, page 3). That argument is not

persuasive because 1) the appellants consider the same examiner,

supervisor and appeal conference specialist to be wrong about all

of the other claims, and 2) like a predecessor of our reviewing

appellate court, we do not consider allowed claims in other

applications or patents. *See In re Gyurik*, 596 F.2d 1012, 1018 n.

15, 201 USPQ 552, 558 n.15 (CCPA 1979); *In re Giolito*, 530 F.2d 397,

400, 188 USPQ 645, 648 (CCPA 1976).

7

Conclusion

We have considered the appellants' request for rehearing but,

for the above reasons, we decline to make any change to our

decision. Hence, with respect to 1) our affirmance of the rejection

of claims 1-3, 5-10, 12-14, 16 and 17 under 35 U.S.C. § 102(b) over

McIlroy, and 2) the new ground of rejection of claim 11 under

35 U.S.C. § 112, second paragraph, the request for rehearing is

denied. However, the appellants' request that we denominate the

affirmance of the rejection of claims 1-3, 5-10, 12-14, 16 and 17

under 35 U.S.C. § 102(b) over McIlroy as involving a new ground of

rejection is granted.

GRANTED-IN-PART

Jerry Smith
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Terry J. Owens   )   BOARD OF PATENT
Administrative Patent Judge   )   APPEALS AND
)   INTERFERENCES
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Appeal No. 2004-1825
Application 09/402,563

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